

The Office Action requires restriction between Group I, comprising claims 1-26, drawn to a coated roll, and Group II, comprising claims 27-41, drawn to a method of making a coated roll. Applicants hereby provisionally elect Group I with traverse.

Claims 27-41 are directed to a method of making a roll having a core and a coating, and recite each of the features of the coated roll of elected claim 1.

Under MPEP §806.05(f), inventions for a product and a corresponding manufacturing process of making that product are independent and distinct only if (1) the process as claimed can be used to make another and materially different products and/or (2) that the product as claimed can be made by another and materially different process.

The Office Action alleges that the coating can be made by a materially different process such that "[i]nstead of forming the coating on the core, the coating layer can be made separately on a transfer film, placed on the core [and] then remove the transfer film". For at least the following reasons, this ground is insufficient to establish a prima facie case for regarding restriction under MPEP §806.05(f) and the Administrative Procedure Act (APA) requirements for procedural and substantive due process. See Dickinson v. Zurko, 527 U.S. 150, 119 S.Ct. 1816 (1999).

"Providing a coating", as now recited in claims 27-41, encompasses any method for creating a roll comprising a core and having a coating over the core. Moreover, the specification states the coating can be applied onto the core "by any suitable coating process" (emphasis added). Such processes include (but are not limited to) electrostatic spraying, wet coating, dip coating, plasma spraying and vacuum deposition. See the paragraph between page 13, line 27 - page 14, line 3. Furthermore, the process put forth in the Office Action yields the same product, functionally and materially, as set forth in claims 1-26. The use of an intermediate transfer film is therefore not precluded by any of the independent claims.

Thus, the asserted process is literally within the scope of claims 27-41 as pending. Therefore, the asserted process is not a "materially different" process from that claimed.

Even if the related claims in Groups I and II are determined to be distinct, under MPEP §808.02 the Examiner must show either (1) separate classification, (2) separate status in the art, or (3) a different field of search. While the Examiner has identified Groups I and II under separate classes, the subject matter overlap of all claims 1-41 within the ceramic art enables a search for one group to be co-extensive with the remaining group. Thus, it is respectfully submitted that the search and examination of the entire application could be made without serious burden.

MPEP §803 states that "if the search and examination of the entire application can be made without serious burden, the Examiner must examine it on the merits even though it includes claims to distinct or independent inventions" (emphasis added). It is respectfully submitted that this policy should apply in the present application in order to avoid unnecessary delay and expense to Applicant and duplicative examination by the Patent Office. Accordingly, Applicants respectfully request reconsideration and withdrawal of the Restriction Requirement.

Because the asserted process, on which the Restriction Requirement is based, is not a materially different process to obtain the claimed product and because the Office Action has not identified a materially different product that could be obtained using the claimed process, the Office Action has failed to meet the requirements either of MPEP §806.05(f) or the APA. Thus, the Office Action has failed to establish a prima facie case that restriction is proper.

For at least the reasons set forth above, Applicants respectfully submit that the application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-41 are earnestly solicited.

Should the Examiner believe that anything further is desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact Applicants' representative at the telephone number listed below.

Respectfully submitted,



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Attachment:
Appendix

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<p>DEPOSIT ACCOUNT USE AUTHORIZATION Please grant any extension necessary for entry; Charge any fee due to our Deposit Account No. 24-0037</p>
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APPENDIX

Changes to Claims:

The following is a marked-up version of the amended claims:

1. (Amended) A roll, comprising:

a core; and

a coating comprising a glass material ~~formed~~ provided over the core, wherein the glass material can be electrically charged and discharged.

27. (Amended) A method of making a roll, comprising ~~forming~~ providing a coating over a core, the coating comprising a glass material that can be electrically charged and discharged.

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